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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/849,759  | 05/04/2001  | Geroge Ann Pieters   | 00-053              | 2676             |
| 29883   | 7590        | 06/16/2005           | EXAMINER            |                  |
| BARTONY & HARE<br>LAW & FINANCE BUILDING, SUITE 1801<br>429 FOURTH AVENUE<br>PITTSBURGH, PA 15219 |             |                      | BOYD, JENNIFER A    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1771                |                  |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                    |  |
|------------------------------|------------------|--------------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)       |  |
|                              | 09/849,759       | PIETERS, GEROGEANN |  |
|                              | Examiner         | Art Unit           |  |
|                              | Jennifer A. Boyd | 1771               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 March 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7,10-16,19 and 24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7,10-16,19 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. In view of the Appeal Brief filed on March 22, 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

2. The Applicant's Remarks, filed March 22, 2005, have been entered and have been carefully considered. Claims 1 – 7, 10 – 16, 19 and 24 are pending. In view of Applicant's arguments, the Examiner withdraws the previously set forth rejection as detailed in paragraph 3 of the Office Action dated June 24, 2004. After another search was conducted, additional prior art has been found which renders the invention as currently claimed unpatentable for reasons herein below.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 – 7 and 10 - 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly (US 4,379,553).

Kelly is directed to a bowling lane with a fire retardant decorative surface (Title).

As to claim 1, Kelly teaches that the bowling lane surface comprises alternately laid crepe paper sheets with glass cloth or net sheets which can be impregnated with a thermosetting resin. The thermosetting resin may be any of the thermosetting resins conventionally used in the production of decorative laminates (column 4, lines 60 – 69). Kelly mentions that acrylic can be used as the thermosetting resin (column 5, lines 55 – 65). Kelly further adds that a thermosetting resin composition overlays may be used on the surface of the laminate. Typical thermosetting resin composition overlays are described in US Patent Nos. 3,135,643 and 3,371,071, which herein are incorporated by reference (column 6, lines 25 – 40). According to MPEP 2163.07(b), the phrase “incorporated by reference” means that the information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as

part of the text of the application as filed. US Patent 3,373,071 teaches that the overlay may comprise acrylic. The Examiner equates the overlay to Applicant's "outer protective layer", the crepe paper sheet to Applicant's "decorative layer" and one of the glass cloth layers to Applicant's "base sheet". The thermosetting impregnating resin is equated to the "bonding material" and the "inner protective layer". It should be noted that the method of forming the "inner protective layer", the "bonding material" and the "outer protective layer" is not germane to the issue of patentability of the composite material itself. Therefore, the limitation of "an aqueous acrylic polymer dispersion medium which is applied wet and bond upon drying" is not given any patentable weight.

As to claim 2, the Examiner submits that a glass cloth would have a higher strength than the acrylic.

As to claim 3, the Examiner has equated the glass cloth or net sheet to Applicant's "base material".

As to claim 4, Kelly teaches that the bowling lane surface comprises alternately laid crepe paper sheets with glass cloth or net sheets which can be impregnated with a thermosetting resin (column 4, lines 60 – 69). The Examiner equates an additional glass cloth or net sheet layer to Applicant's "woven backing".

As to claims 5 – 7, Kelly teaches an acrylic overlay which is inherently water resistant and translucent as required by Applicant.

As to claims 10 - 11, Kelly teaches that the "decorative layer" can be creped paper (column 4, lines 60 – 69). It should be noted that creping provides a textured or wrinkled surface.

As to claims 12 - 13, Kelly teaches that the acrylic overlay is applied to the creped paper (columns 5 - 6). The Examiner submits that the overlay would provide Applicant's "hard finish" or "plate finish".

***Claim Rejections - 35 USC § 103***

6. Claims 1, 5 – 6, 12, 14 - 16, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groody (US 4,065,596) in view of Iovine et al. (US 4,948,822).

Groody is directed to an artist's board (Title) having dimensional stability with a resiliently flexible paintable surface (column 4, lines 15 – 25).

As to claims 1, 6, 15 and 24, Groody teaches that the board comprises three coextensive members: a rear stiffener member 10, a front paintable member 12 and an intermediate resiliently flexible core member 14, all three members being laminated together with the use of a suitable adhesive between the members 10 and 14 and 12 and 14 (column 1, lines 55 – 65). See Figures 1 – 3. The front paintable member 12 can be made out of paper, cotton duck or linen and is treated to provide an outer white or off-white surface upon which the artist can paint with oil or acrylics so that they will dry by outward evaporation and not by absorption through the member 12. The paper, cotton duck or linen can be coated or impregnated with emulsions of various resins. Groody notes that the front paintable member is impregnated with an aqueous emulsion such as acrylic polymer emulsions and then dried (column 2, lines 1 – 15). It is the position of the Examiner that the acrylic emulsion will provide a water resistant surface as required by claim 6. The front paintable member 12 is equated to Applicant's "decorative layer" and the acrylic polymer emulsion for coating or impregnating the member is equated to

Applicant's "outer protective layer". The intermediate layer or core 14 is a sheet of resiliently flexible material (column 3, lines 20 – 26). The Examiner equates the intermediate layer to Applicant's "layer of base material". The adhesive applied between the layers 12 and 14 and layers 10 and 14 can be applied as a continuous layer (column 3, lines 40 – 47). The layer of adhesive between layers 12 and 14 is equated to Applicant's "bonding material" and the layer of adhesive between layers 10 and 14 is equated to Applicant's "inner protective layer".

As to claims 12 and 14, Groody teaches that the front member 12 can comprise cotton duck material which is coated or impregnated with emulsions of various resins (column 2, lines 1 – 10). The coating provides a flexible resilience on the order of 65 – 80 Shore A (column 3, lines 49 – 55 and column 4, lines 1 – 5). According to Textile Glossary by Celanese Acetate, "duck" is a compact, firm, heavy plain weave fabric. It is the position of the Examiner that the interlacing of the warp and weft yarns would provide Applicant's "textured" appearance

As to claims 1, 15 and 24, Groody fails to teach that the bonding material used to bind the decorative layer and the base layer comprises an aqueous acrylic polymer dispersion medium which is applied wet and bonds upon drying. As to claim 5, Groody fails to teach that the inner protective layer is water resistant.

Iovine et al. is directed to a laminating adhesive for forming flexible laminates having a high bond strength, and a high degree of both humidity and water resistance (Abstract). The adhesive composition comprises acrylic polymer prepared by a "core-shell" emulsion polymerization process (column 2, lines 20 – 35). The laminates of the invention may contain laminae of a wide variety of flexible materials such as films, wovens, non-wovens, paper,

paperboard and foams (column 6, lines 4 – 21). The laminates of the invention are formed by applying the adhesive emulsion to substrate by a number of techniques. The adhesive is coated on a film and allowed to dry at room temperature (or dried at moderate heat). The adhesive film is then laminated to a desired substrate (column 6, lines 20 – 45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use acrylic emulsion adhesive as suggested by Iovine to laminate the layers of Groody motivated by the desire to create a flexible laminate with a high bond strength and high degree of humidity and water resistance.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1 – 7, 10 – 16, 19 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Boyd  
June 7, 2005



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